

**REMARKS**

**I. Status of Claims**

Claims 148-173 are currently pending in this application. Claims 1-64, 66-87, and 136-146 were previously canceled, and claims 65, 88-135, and 147 have been canceled without prejudice herein. Claims 148-173 have been added. Support for these claims can be found in the application as originally filed.

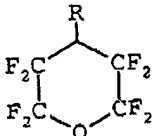
For the Examiner's convenience, Applicant points out in the following Table 1 the specific written description support in the specification for the elements of new claims 148-173.

**Table 1.**

<b><u>Element</u></b>	<b><u>Support in Specification</u></b>
A structured composition comprising at least one liquid fatty phase which comprises: (i) at least one fluoro oil; and (ii) wherein the at least one liquid fatty phase is structured with at least one polymer with a weight-average molecular mass of less than or equal to 1,000,000, comprising: a) a polymer skeleton having hydrocarbon-based repeating units containing at least one hetero atom, and b) optionally at least one fatty chain chosen from at least one pendent fatty chain and at least one terminal fatty chain, wherein the at least one fatty chain comprises from 6 to 120 carbon atoms, is linked to the hydrocarbon-based units, and is optionally functionalized, wherein the at least one liquid fatty phase and the at least one polymer form a physiologically acceptable medium.	See claim 1, as originally filed.
- wherein the at least one hetero atom in the hydrocarbon-based repeating units of the polymer is a nitrogen atom.	See claim 3, as originally filed.
- wherein the hydrocarbon-based repeating units are amide groups and said polymer	See claim 4, as originally filed and p. 10, Ins. 4-10 of the Specification.

skeleton is a polyamide skeleton.	
<p>- wherein said at least one structuring polymer is chosen from polyamide polymers of formula (I):</p> $\text{R}^1\text{-O}\left[\text{C}(=\text{O})\text{-R}^2\text{-C}(=\text{O})\text{-N}(\text{R}^4)\text{-R}^3\text{-N}(\text{R}^4)\right]_n\text{-C}(=\text{O})\text{-R}^2\text{-C}(=\text{O})\text{-O-R}^1 \quad (\text{I})$ <p>in which:</p> <ul style="list-style-type: none"> <li>- n is an integer which represents the number of amide units such that the number of ester groups present in said at least one polyamide polymer ranges from 10% to 50% of the total number of all ester groups and all amide groups comprised in said at least one polyamide polymer;</li> <li>- R<sup>1</sup>, which are identical or different, are each chosen from alkyl groups comprising at least 4 carbon atoms and alkenyl groups comprising at least 4 carbon atoms;</li> <li>- R<sup>2</sup>, which are identical or different, are each chosen from C<sub>4</sub> to C<sub>42</sub> hydrocarbon-based groups, with the proviso that at least 50% of all R<sup>2</sup> are chosen from C<sub>30</sub> to C<sub>42</sub> hydrocarbon-based groups;</li> <li>- R<sup>3</sup>, which are identical or different, are each chosen from organic groups comprising atoms chosen from carbon atoms, hydrogen atoms, oxygen atoms and nitrogen atoms, with the proviso that R<sup>3</sup> comprises at least 2 carbon atoms; and</li> <li>- R<sup>4</sup>, which are identical or different, are each chosen from hydrogen atoms, C<sub>1</sub> to C<sub>10</sub> alkyl groups and a direct bond to at least one group chosen from R<sup>3</sup> and another R<sup>4</sup> such that when said at least one group is chosen from another R<sup>4</sup>, the nitrogen atom to which both R<sup>3</sup> and R<sup>4</sup> are bonded forms part of a heterocyclic structure defined in part by R<sup>4</sup>-N-R<sup>3</sup>, with the proviso that at least 50% of all R<sup>4</sup> are chosen from hydrogen atoms.</li> </ul>	See claim 17, as originally filed.
<p>- wherein said at least one structuring polymer is present in the composition in an amount ranging from 0.5% to 80% by weight relative to the total weight of the composition.</p>	See claim 20, as originally filed.
<p>- wherein the at least one fluoro oil is chosen from fluorosilicone compounds of formula (II):</p>	See claim 21, as originally filed.

$  \begin{array}{c}  R_1 \\    \\  R_1 - Si - O - Si - O - Si - O - Si - R_1 \\    \quad   \quad   \quad   \\  R_1 \quad R_1 \quad CH_3 \quad R_1 \\  \quad \quad \quad   \\  \quad \quad \quad R \\  \quad \quad \quad   \\  \quad \quad \quad R_f  \end{array}  \quad (II)  $ <p>wherein: R is chosen from linear and branched divalent alkyl groups containing from 1 to 6 carbon atoms; R<sub>f</sub> is a fluoroalkyl radical containing from 1 to 9 carbon atoms; R<sub>1</sub> is independently chosen from C<sub>1</sub>-C<sub>20</sub> alkyl radicals, hydroxyl radicals, and phenyl radicals; m ranges from 0 to 150; and n ranges from 1 to 300.</p>	
<p>- wherein the at least one fluoro oil is chosen from fluorosilicone compounds of formula (III) below:</p> $  \begin{array}{c}  CH_3 \\    \\  H_3C - Si - O - Si - O - Si - O - Si - CH_3 \\    \quad   \quad   \quad   \\  CH_3 \quad CH_3 \quad R \quad CH_3 \\  \quad \quad \quad   \\  \quad \quad \quad CF_3  \end{array}  \quad (III)  $ <p>wherein: R is chosen from divalent methyl, ethyl, propyl, and butyl groups; m ranges from 0 to 80; and n ranges from 1 to 30.</p>	<p>See claim 23, as originally filed.</p>
<p>- wherein the at least one fluoro oil is chosen from perfluorocycloalkyls of formula (IV):</p> $  (CF_2)_n \left[ CF - (CF_2)_p - F \right]_m \quad (IV)  $ <p>wherein: n is equal to 4 or 5; m is equal to 1 or 2; and p ranges from 1 to 3; with the proviso that when m = 2, the (CF<sub>2</sub>)<sub>p</sub>-F groups are not necessarily alpha to each other.</p>	<p>See claim 23, as originally filed.</p>
<p>- wherein the at least one fluoro oil is chosen from fluoroalkyl and heterofluoroalkyl compounds of formula (V):</p> $  CH_3 - (CH_2)_n - [Z]_t - X - CF_3 \quad (V)  $ <p>wherein: t is 0 or 1; n ranges from 0 to 3;</p>	<p>See claim 26, as originally filed.</p>

<p>X is chosen from linear and branched divalent perfluoroalkyl radicals containing from 2 to 5 carbon atoms; and Z is chosen from O, S, NH, <math>-(CH_2)_n-CH_3</math>, and <math>-(CF_2)_m-CF_3</math>, wherein m ranges from 2 to 5.</p>	
<p>- wherein the at least one fluoro oil is chosen from perfluoroalkane compounds of formula (VI):</p> $CF_3-(CF_2)_n-CF_3 \quad (VI)$ <p>wherein n ranges from 2 to 6.</p>	<p>See claim 28, as originally filed.</p>
<p>- wherein the at least one fluoro oil is chosen from perfluoromorpholine derivatives of formula (VII):</p>  <p style="text-align: center;">(VII)</p> <p>wherein R is chosen from C<sub>1</sub>-C<sub>4</sub> perfluoroalkyl radicals.</p>	<p>See claim 30, as originally filed.</p>
<p>- wherein the at least one fluoro oil is chosen from the perfluoropolyethers of formulae (VIII) and (IX):</p> $F-\left[CF(CF_3)-CF_2-O\right]_n-CF_2-CF_3 \quad (VIII)$ <p>wherein n ranges from 7 to 30; and</p> $CF_3-\left[O-CF(CF_3)-CF_2\right]_m-\left[O-CF_2\right]_p-OCF_3 \quad (IX)$ <p>wherein the ratio m/p ranges from 20 to 40, and the molecular weight ranges from 500 to 20,000.</p>	<p>See claim 32, as originally filed.</p>
<p>- wherein the at least one fluoro oil is chosen from fluorosilicone compounds of formula (X):</p> $CF_3-(CF_2)_k-(CH_2)_l-O-C(=O)-N(R_1)-(CH_2)_p-Si(R_2)-O-\left[Si(R_2)_2\right]_2 \quad (X)$ <p>wherein: k ranges from 1 to 17; l ranges from 1 to 18; p ranges from 1 to 6; R<sub>1</sub> is chosen from hydrogen and C<sub>1</sub>-C<sub>6</sub> alkyl radicals; R<sub>2</sub> is chosen from C<sub>1</sub>-C<sub>6</sub> alkyl radicals and -OSi(R<sub>3</sub>)<sub>3</sub>, R<sub>3</sub> being chosen from C<sub>1</sub>-C<sub>4</sub> alkyl radicals.</p>	<p>See claim 33, as originally filed.</p>
<p>- wherein the at least one fluoro oil is chosen</p>	<p>See claim 35, as originally filed.</p>

<p>from fluoroalkylsilicones of formula (XI):</p> $  \begin{array}{c}  R_1 \\    \\  R_2-Si-O-Si-O-Si-O-Si-O-Si-R_2 \\    \quad   \quad   \quad   \quad   \\  R_1 \quad R_1' \quad R_3 \quad R_1' \quad R_1 \\    \quad   \quad   \quad   \quad   \\  (CH_2)_2 \quad R_F \quad R_3 \quad R_1' \quad R_1 \\    \quad   \quad   \quad   \quad   \\  m \quad n \quad p  \end{array}  \quad (XI)  $ <p>wherein:  <math>R_1</math> and <math>R_1'</math> are independently chosen from linear and branched alkyl radicals containing from 1 to 6 carbon atoms, and phenyl radicals;  <math>R_2</math> is chosen from <math>R_1</math>, -OH, and <math>-(CH_2)_f-R_F</math>, <math>f</math> being an integer ranging from 0 to 10;  <math>R_3</math> is chosen from linear and branched alkyl radicals containing from 6 to 22 carbon atoms;  <math>R_F</math> is chosen from <math>-(CF_2)_q-CF_3</math>, <math>q</math> being an integer ranging from 0 to 10;  <math>m</math> and <math>n</math> are independently chosen from an integer ranging from 1 to 50; and  <math>p</math> is an integer ranging from 0 to 2,000.</p>	
<p>- wherein the at least one fluoro oil is chosen from fluoroalkylsilicones of formula (XII):</p> $  \begin{array}{c}  R_4 \\    \\  R'_F-(CH_2)_2-Si-O-Si-O-Si-R_5 \\    \quad   \quad   \quad   \\  R_4 \quad R_4 \quad R_4 \quad R_4  \end{array}  \quad (XII)  $ <p>wherein:  <math>R_4</math> is chosen from linear and branched alkyl radicals containing from 1 to 6 carbon atoms, and phenyl radicals;  <math>R_5</math> is chosen from linear and branched alkyl radicals containing from 6 to 22 carbon atoms, and phenyl radicals;  <math>R'_F</math> is chosen from <math>-(CF_2)_s-CF_3</math>, wherein <math>s</math> is an integer ranging from 0 to 15; and  <math>t</math> is an integer ranging from 1 to 2,000.</p>	<p>See claim 37, as originally filed.</p>
<p>- wherein the at least one fluoro oil is present in an amount ranging from 0.1% to 50% by weight, relative to the total weight of the composition.</p>	<p>See claim 39, as originally filed.</p>
<p>- further comprising at least one additional oil, other than the said at least one fluoro oil.</p>	<p>See claim 40, as originally filed.</p>
<p>- wherein said at least one liquid fatty phase further comprises one additional non-volatile oil, other than said fluoro oil.</p>	<p>See claim 45, as originally filed.</p>
<p>- further comprising at least one volatile solvent.</p>	<p>See claim 41, as originally filed.</p>
<p>- wherein the at least one liquid fatty phase further comprises an apolar oil.</p>	<p>See claim 48, as originally filed.</p>

- wherein the at least one liquid fatty phase is present in an amount ranging from 5% to 99% by weight, relative to the total weight of the composition.	See claim 49, as originally filed.
- further comprising at least one dyestuff.	See claim 51, as originally filed.
- further comprising at least one additive chosen from water, antioxidants, essential oils, preserving agents, fragrances, fillers, waxes, fatty compounds that are pasty at room temperature, neutralizers, polymers that are liposoluble or dispersible in the physiologically acceptable medium, cosmetic agents, dermatological active agents, and dispersants.	See claim 54, as originally filed.
- wherein the composition is in the form of a rigid gel or stick.	See claims 56 and 58, as originally filed.
- wherein the composition is a cosmetic composition chosen from mascara, eyeliner, a foundation, a lipstick, a blusher, a deodorant product, a make-up-removing product, a body make-up product, an eye shadow, a face powder, a concealer product, a shampoo, a conditioner, an antisen product, a bodycare product, a facial care product, or a nail varnish.	See claim 57, as originally filed.
A cosmetic process for caring for, making up, or treating a keratin material, comprising the application to the keratin material of a cosmetic composition comprising: (i) at least one fluoro oil; and (ii) wherein the at least one liquid fatty phase is structured with at least one polymer with a weight-average molecular mass of less than or equal to 1,000,000, comprising: a) a polymer skeleton having hydrocarbon-based repeating units containing at least one hetero atom, and b) optionally at least one fatty chain chosen from at least one pendent fatty chain and at least one terminal fatty chain, wherein the at least one fatty chain comprises from 6 to 120 carbon atoms, is linked to the hydrocarbon-based units, and is optionally functionalized.	See claim 61, as originally filed.

## **II. Rejection Under 35 U.S.C. § 103**

Claims 65, 88-135, and 147 were rejected under 35 U.S.C. § 103 as allegedly obvious over the combination of U.S. Patent No. 5,998,570 to Pavlin et al. ("the '570 patent"); U.S. Patent No. 6,749,173 to Arnaud et al. ("the '173 patent"); U.S. Patent No. 6,224,851 to Bara ("the '851 patent"); U.S. Patent No. 6,399,080 to Bara ("the '080 patent"); and U.S. Patent No. 6,203,780 to Arnaud et al. ("the '780 patent"). Although Applicant has canceled the rejected claims, Applicant respectfully traverses the rejection to the extent the Office would choose to maintain it over currently pending claims 148-173.

In making a rejection under 35 U.S.C. § 103, the Office has the initial burden to establish a *prima facie* case of obviousness. See M.P.E.P. § 2143. To meet this burden, the Office must point to some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to combine reference teachings with a reasonable expectation of success. See M.P.E.P. §§ 2143.01 and 2143.02; *In re Fine*, 5 U.S.P.Q.2d 1596, 1598, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Both the motivation and the reasonable expectation of success must be found in the prior art references, not in Applicant's disclosure. See *In re Vaeck*, 20 U.S.P.Q.2d 1438, 947 F.2d 488 (Fed. Cir. 1991). In the present case, the Office has not met either of these criteria with respect to the proposed combination or modifications of the compositions of the '570 patent and, therefore, has not established a *prima facie* case of obviousness.

**A. The Office has not established that the references provide the requisite motivation, suggestion, or teaching of the desirability of making this specific combination of the present invention.**

The threshold for establishing a motivation to combine is high, requiring "clear and particular" evidence of a motivation to combine. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617, 175 F.3d 994, 999 (Fed. Cir. 1999). As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Id.*, at 1617, 175 F.3d at 999. This evidence must be explicitly set forth by the Office in its rejection. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1433, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (emphasis added).

In the present case, the Office has failed to set forth sufficient evidence of a motivation to combine the references in the manner proposed, as required. In fact, the references reveal that no motivation existed at the time the invention was made to make the Office's proposed modification or combination, and the Office has merely pointed to disclosure in the individual references of the individual components of the claims. However, this is not sufficient to satisfy the Office's burden for establishing *prima facie* obviousness, and therefore, the rejection is legally improper and should be withdrawn, as discussed in detail below.

**1. The Office does not offer sufficient motivation to combine the references**

The Office improperly bases its finding of obviousness on the assertion that the five references contain various elements of the claims. The Office asserts that the '570 patent teaches the claimed polymer. (*Id.* at p. 3.) However, while the Office recognizes



that the '570 patent does not teach the fluoro oil or several other recited elements of the claims, including the additional oil, the apolar oil, and the dyestuff, the Office attempts to rectify this deficiency by relying on the '173, '851, '080, and '780 patents as teaching the missing elements. (*Id.* at pp. 2-3.) From this combination, the Office concludes that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the compositions of [the '570 patent] and combine it with the fluoro oils of [the '173, '851, '080, and '780 patents] expecting beneficial effect to the cosmetic products when applied." (*Id.*) The Office asserts that the idea or motivation to combine the elements of the compositions of the five cited references "stems from the teaching of the four patents that these fluoro oils are transfer resistant agents" and, therefore, the Office concludes, the present claims are obvious. (Office Action, p. 3.) Applicant disagrees.

None of the '173, '851, '080, and '780 patents teaches or suggests combining the fluoro oils taught therein with the compositions of the '570 patent, and in fact, several of them teach away from making such a combination, as discussed in detail below.

**a. The '570 Patent**

Applicant notes that the '570 patent is not directed to transfer resistant cosmetic products; rather, it relates to methods for the preparation of gelling agents. See e.g., col. 1, lns. 14-15, and claim 1. In fact, the only embodiment of any formulation disclosed by the '570 patent is in the form of a candle. See Example 25. As to the Office's alleged motivation having to do with the teachings in the '173, '851, '080, and '780 patents of transfer resistance, the Office provides no explanation whatsoever as to why one of skill in the art would have wanted to make compositions containing the

gelling agents of the '570 patent transfer resistant. Nor is there any suggestion in the '570 patent that when the disclosed gelling agent is used in cosmetic compositions the compositions have a tendency to transfer upon application. Accordingly, there is simply no suggestion in the '570 patent that would have led the skilled artisan to add fluoro oils to obtain a transfer resistant cosmetic composition, as the Office alleges.

**b. The '173 Patent**

The '173 patent, which teaches transfer-free compositions containing fluorinated silicone compounds, does not provide the requisite motivation for its combination with the '570 patent. As above, the Office provides no explanation as to how the particular teachings of the '173 patent would have motivated its combination with the '570 patent, or why one of skill in the art would have wanted to make the '570 compositions transfer free. Furthermore, the '173 patent actually teaches away from combining the fluoro oils disclosed therein with the composition described in the '570 patent if a transfer-free composition is desired, because it cautions against the use of a large percentage of hydrocarbon oil in the composition. The '173 patent states that "hydrocarbon oils, which are known to contribute in particular comfort to a cosmetic or dermatological composition, have the disadvantage of increasing the transfer of such a composition." Col. 2, Ins. 23-26. The '570 patent, however, teaches a majority percentage of hydrocarbon oil present in the composition. See *e.g.*, col. 17, Ins. 35-38 and example 25. Therefore, one of ordinary skill in the art, when attempting to formulate a transfer-free composition, would not be led to combine these two references.

**c. The '080 Patent**

The '080 patent, like the '173 patent, does not teach or suggest the combination of the fluoro oils disclosed therein with the compositions of the '570 patent. While the '080 patent also teaches compositions containing fluoruous compounds with "good filmographic properties and resistance to water and sebum," it does not provide the requisite motivation for its combination with the '570 patent. The Office provides no explanation as to how the particular teachings of the '080 patent would have motivated the proposed combination or why one of skill in the art would have wanted to make the '570 compositions transfer free. To the contrary, the '080 patent also teaches away from the Office's proposed combination. In fact, it directly advises against such a combination, stating that the use of fluoruous oils in the formulation of cosmetic compositions is "difficult to achieve, because of the inherent incompatibility of the fluoruous oils with numerous polar and apolar hydrocarbonaceous compounds." Col. 1, Ins. 11-18. Therefore, as discussed above, in view of the fact that hydrocarbon oil may be a majority component in the '570 compositions, one of ordinary skill in the art, when attempting to formulate a transfer-free composition, would not be led to combine these two references.

**d. The '851 and '780 Patents**

Like the references discussed above, the '851 and '780 patents do not teach or suggest the combination of the fluoro oils disclosed therein with the compositions of the '570 patent. While the '851 patent also teaches compositions containing fluoruous compounds to avoid transfer, it does not provide the requisite motivation for its combination with the '570 patent. Likewise, the '780 patent discloses compositions

containing fluorosilicone compounds, which are resistant to transfer, but it does not provide the requisite motivation for its combination with the '570 patent either. The Office provides no explanation as to how the particular teachings of the '851 and '780 patents would have motivated the proposed combinations or why one of skill in the art would have wanted to make the '570 compositions transfer free.

Accordingly, the Office has not sufficiently pointed to any specific teaching or suggestion in any of the references or in the knowledge of those skilled in the art that would have motivated the skilled artisan to combine them, as it must to satisfy its burden of establishing a case of obviousness. For this reason alone, the rejection is improper and should be withdrawn.

2. The teaching of the individual components in the individual references is not enough to defeat the patentability of the claimed invention

Even though the individual components of the presently claimed invention may be found separately in the references of record, these separate disclosures do not defeat the patentability of the composition as a whole. Merely identifying each of the claimed elements in the prior art is not sufficient to establish a *prima facie* case of obviousness. If it were, any chemical dictionary would render every composition unpatentable, a result that is clearly not intended in the patent system.

As the Office is well aware, the Federal Circuit has held that "[m]ost if not all inventions arise from a combination of old elements . . . . However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (citations omitted). It is not sufficient to merely "find every element of a

claimed invention in the prior art” and for the Office to “use the claimed invention itself as a blue print for piecing together elements . . . . Such an approach would be an illogical and inappropriate process by which to determine patentability.” *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (citations and quotations omitted).

When a claimed invention combines known elements, a patentability determination rests on “whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.” *In re Beattie*, 24 U.S.P.Q.2d 1040, 1042, 974 F.2d 1309, 1311 (Fed. Cir. 1992) (citations omitted). More specifically, “[w]hen an obviousness determination is based on multiple prior art references, there must be a showing of some ‘teaching, suggestion, or reason to combine the references.’” *Winner Int’l Royalty Corp. v. Wang*, 53 U.S.P.Q.2d 1580, 1586, 202 F.3d 1340, 1348 (Fed. Cir. 2000), citing *Gambro Lundia AB v. Baxter Healthcare Corp.*, 42 U.S.P.Q.2d 1378, 1383, 110 F.3d 1573, 1579 (Fed. Cir. 1997). This has not been done in the present case.

When the “rigorous” standards of the prevailing law are applied in this case, it becomes apparent that the combination of individually claimed elements from the cited references is improper. There is no specific suggestion of the desirability of the combination here, as discussed in detail above. The Office has merely found references that may separately teach components of the claimed invention but that fail to motivate one to use of all of the claimed components together. The Office has not pointed to any teaching in the references or in the knowledge of those skilled in the art particularly suggesting the desirability of their combination. Accordingly, these

references could not have provided motivation for one of ordinary skill in the art to reach the presently claimed invention, and the rejection should be withdrawn for this additional reason.

**B. The Office has not set forth any evidence of an expectation of success.**

As discussed above, in the present case, the prior art, at best, individually discloses the various elements of the presently claimed invention. Accordingly, only in hindsight could it have been obvious to one with the cited references before her to have combined their teachings in the claimed manner with any reasonable expectation of success. The Office, however, may not pick and choose among isolated disclosures in references to defeat patentability of a claimed invention after seeing the blueprint the claimed invention provides. Such picking and choosing amounts to improper hindsight reconstruction and is prohibited. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

As discussed above, the '173, '851, '080, and '780 patents teach transfer resistant compositions containing fluoro compounds; however, they do not teach or suggest that the fluoro compounds disclosed therein would be expected to limit the transfer of all compositions, such as, for example, those specifically found in the '570 patent. In fact, both the '173 and '851 patents teach away from the use of fluoro compounds with hydrocarbon compounds, which may be a predominant component in the compositions of the '570 patent, as explained above. Accordingly, one of ordinary skill in the art reading the '173, '851, '080, and '780 patents would not have had the requisite reasonable expectation of success in the proposed combination of the fluoro

compounds therein with the compositions of the '570 patent, and in fact, would have expected such a combination to have been unsuccessful.

Accordingly, for at least this additional reason that there would have been no reasonable expectation of success in the Office's proposed combination, the rejection is legally improper and should be withdrawn.

In light of the foregoing, Applicant respectfully submits that the Office has failed to establish a *prima facie* case of obviousness, and thus, requests that the rejections under 35 U.S.C. § 103(a) be withdrawn.

**C. Under 35 U.S.C. § 103(c) the '173, '851, and '780 patents cannot be prior art against the present application.**

Additionally, under 35 U.S.C. § 103(c), Applicant notes that the '173, '851, and '780 patents cannot be prior art against the present application, and Applicant has established above that the presently claimed invention is not *prima facie* obvious over the '570 patent alone or in combination with these three patents and the '080 patent. Accordingly, the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

As amended by the American Inventors Protection Act of 1999 ("AIPA"), § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections of (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Further, M.P.E.P. § 706.02(I)(1) states:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now

disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” This change to 35 U.S.C. § 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999. . . .

The present application has a filing date of January 17, 2002, which is after November 29, 1999, the effective date of § 103(c). As is clear from the face of the ‘173, ‘851, and ‘780 patents, they were filed before, but issued after, the priority filing date of the present application, *i.e.* after, the present application’s January 17, 2001, French filing date, and thus, they cannot qualify as prior art under any section of 35 U.S.C. § 102 other than § 102(e). Applicant submits that the present application and the ‘173, ‘851, and ‘780 patents were all assigned to L’Oréal or subject to an obligation of assignment to L’Oréal at the time the presently claimed invention was made. Thus, the ‘173, ‘851, and ‘780 patents are not legally valid as prior art against the present application, as set forth in detail above. Accordingly, Applicant respectfully submits that the rejection is improper, and requests that it be withdrawn.

### **III. Copending Applications**

In Table 2 of the Amendment filed on June 10, 2004, in this case, Applicant noted information regarding 36 copending applications, including the present application, and submitted copies of the pending claims as of that date for every case identified therein. In the following Table 2, Applicant has noted five additional applications that have been filed, and encloses herewith in Exhibit 1 a copy of the copending claims for each additional case. Furthermore, Applicant submits herewith, also with Exhibit 1, copies of the currently pending claims from the following copending applications, which claims have been amended since June 10, 2004: 09/733,898,



09/733,899; 09/733,900; 09/618,066; 09/685,578; 10/203,018; 10/198,931; 09/937,314;  
10/012,029; 10/012,051; 10/046,568; 10/182,830; 10/203,374; 10/312,083; and  
10/787,440. Applicants submit these claims for the Examiner's convenience in  
evaluating any potential issues regarding statutory or obviousness-type double  
patenting.

**Table 2.**

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date/ 371 (c) Date	Inventors	Title	Assignment Recorded (Reel, Frame, Date)	Publication, Date
05725. 0808- 02000	10/918,579	August 16, 2004	Carlos O. PINZON, Paul THAU, and Isabelle BARA	COMPOSITIONS CONTAINING HETEROPOLY- MERS AND OIL- SOLUBLE ESTERS AND METHODS OF USING SAME	Reel 011654, Frame 0869, on April 2, 2001	Not yet published
05725. 0932- 01000	10/933,431	November 22, 2004	Véronique FERRARI	A TRANSFER- FREE COMPOSITION STRUCTURED IN RIGID FORM BY A POLYMER	Reel 012476, Frame 0507, on January 17, 2002	Not yet published
05725. 1003- 01000	10/933,430	November 22, 2004	Nathalie COLLIN	COSMETIC COMPOSITION COMPRISING A POLYMER BLEND	Reel 013142, Frame 0645, on August 1, 2002	Not yet published
05725. 1004- 01000	10/990,475	November 18, 2004	Nathalie COLLIN	USE OF A POLYMER FOR OBTAINING AN EXPRESS MAKE-UP OF KERATIN MATERIALS	Reel 012847, Frame 0285, on April 30, 2002	Not yet published
05725. 1378- 00000	Not yet assigned	December 23, 2004	Wei YU and Véronique FERRARI	COSMETIC COMPOSITION COMPRISING TWO DIFFERENT	Not yet recorded	Not yet published

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date/ 371 (c) Date	Inventors	Title	Assignment Recorded (Reel, Frame, Date)	Publication, Date
				HETERO POLYMERS AND METHOD OF USING SAME		

#### **IV. Information Disclosure Statement/PTO Form 1449**

On June 10, 2004, Applicant submitted an Information Disclosure Statement and 34-page PTO Form 1449. Applicant notes that several of the documents listed on the PTO Form 1449 returned with the present Office Action were crossed through, rather than initialed. Applicant understands that she properly listed those documents and respectfully requests that the Office consider the documents and indicate that the documents were considered. For the Office's convenience, Applicant submits herewith a new Information Disclosure Statement and Form PTO SB/08, listing, *inter alia*, all the documents crossed through by the Office. If the Office disagrees, Applicant would greatly appreciate citation of a regulation or PTO rule establishing that Applicant's submission was improper.

#### **V. Conclusion**

In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

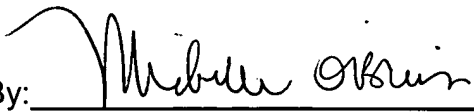
Applicant notes that the Office Action contains numerous characterizations of the invention and the cited art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 7, 2005

By:   
Michelle E. O'Brien  
Reg. No. 46,203

**Attachments:**      **Exhibit 1 -** Pending Claims in Copending Applications

**Exhibit 1**  
Pending Claims in Copending Applications